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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/756,788   | 01/10/2001  | Michael C. Scroggie  | CAT/29US-SCRCO3     | 6599             |
| 31518  | 7590        | 04/18/2005           | EXAMINER            |                  |
| NEIFELD IP LAW, PC<br>4813-B EISENHOWER AVENUE<br>ALEXANDRIA, VA 22304 |             |                      | JANVIER, JEAN D     |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3622                |                  |
| DATE MAILED: 04/18/2005  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/756,788

Applicant(s)

SCROGGIE ET AL.

Examiner

Jean D Janvier

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3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32-91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 32-91 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Arguments***

In response to the Applicant's remarks with respect to the restriction requirement, filed on 01/28/05, the Examiner comes to admit that the restriction requirement, as presented, was inadvertently and erroneously reported. Therefore, the last action is now being vacated in favor of the present action. Having said that, all related arguments are moot in view of the present action.

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 32-37, 59-75, 50-56, 76-91 and 58, drawn to a method of and system for delivering incentives over the Internet comprising a Web site for providing purchasing incentives from multiple sources, a consumer purchase history database based on consumer online shopping activity, a consumer database, which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site **and means for delivering purchasing incentives to consumers by e-mail (disclosed at least in independent claim 32).**

- II. Claims 44-49 drawn to a method of and system for delivering incentives over the Internet comprising a Web site for providing purchasing incentives from multiple sources, a consumer purchase history database based on consumer online shopping activity, a consumer database, which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site **and means for delivering by e-mail notices to said consumers to purchase a specific manufacturer's product** (disclosed at least in independent claim 44).
- III. Claims 38-43, drawn to a method of and system for delivering incentives over the Internet comprising a Web site for providing purchasing incentives from multiple sources, a consumer purchase history database based on consumer online shopping activity, a consumer database, which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site **and means for delivering by e-mail notices which remind consumers to visit said Web site** (disclosed at least in independent claim 38).
- IV. Claim 57, drawn to a method of and system for providing, via a Web site, purchasing incentives from multiple sources such as retailers and manufacturers comprising a personal database, a consumer purchase history database based on

consumer online shopping activity, **means for generating a web page with a consumer-specific display and means for updating said web page.**

Comments:

In Group II, it appears that **means for delivering by e-mail notices to said consumers to purchase a specific manufacturer's product, recited in claim 44,** is equivalent to delivering a purchase incentive to a consumer via e-mail, as disclosed in Group I, whose content is subsequent printed to obtain a paper coupon having the designated manufacturer's product name and/or UPC code imprinted thereon. Further, in Group IV, it appears that **means for informing the consumer by e-mail of new incentives,** as disclosed in claim 57, is equivalent to notifying the consumer by e-mail to visit the Web Site and access his personal web page to view new incentives available to him. If the Applicant agrees with these interpretations, as supported in the specification, then the Applicant can contact the Examiner to discuss ways to amend claims 44 and 57 respectively so that Group I and II, Group III and IV can be respectively examined together. That is, Group I and II will form one group and Group III and IV will another different group.

Meanwhile, the inventions are distinct, each from the other because of the following reasons:

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For example, Inventions I and IV are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed. The subcombination has separate utility by itself such as **means for generating a web page with a consumer-specific display and means for updating said web page.**

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art and required a separate search and hence, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean D Janvier whose telephone number is 308-6287 (571-272-6719 after 4/14/05). The examiner can normally be reached on Monday-Thurs. 9:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. P Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jean D Janvier  
Examiner  
Art Unit 3622

04/07/05

JEAN D. JANVIER  
PRIMARY EXAMINER  
*Jean D Janvier*